

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Official

Applicants: J. Bednorz et al.

Date: December 3, 1998

Serial No.: 08/303,561

Group Art Unit: 1105

Filed: September 9, 1994

Examiner: M. Kopel

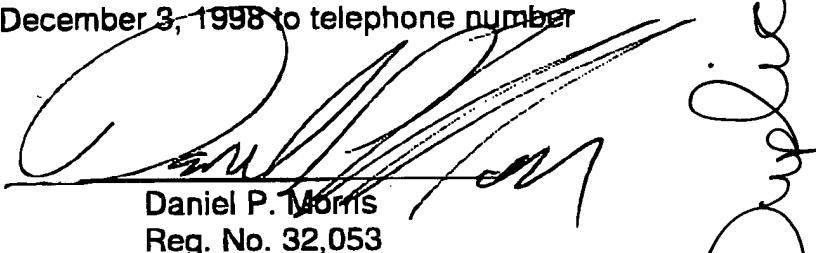
For: NEW SUPERCONDUCTIVE COMPOUNDS HAVING HIGH
TRANSITION TEMPERATURE, AND METHODS FOR THEIR
USE AND PREPARATION

DEC 8 1998

GROUP 1700

The Commissioner of Patents and Trademarks
Washington, D.C. 20231**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this paper is being facsimile transmitted under 37 CFR 1.61(d) to
the U.S. Patent and Trademark Office on December 3, 1998 to telephone number
703-305-5433.


Daniel P. Morris
Reg. No. 32,053Petition for Withdrawal of the Final Rejection
dated June 25, 1998

Applicants petition for withdrawal of the final rejection rejection dated June 25, 1998

for the following reasons:

Claims 24-26, 86-90, 96-135 and 137-142 have been rejected under 35 USC 102 (a) as anticipated by the Asahi Shinbum article and have been rejected under 35 USC 103 as being unpatentable over the Asahi Shinbum article. Applicants have disagreed for various reasons of record. One of those reasons is that applicants have proven that

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the conception of their invention was in the United states prior to the date of the Asahi Shinbum article , November 28, 1986, and applicants have proven that they were diligent from prior to the date of the Asahi Shinbum article by instructing coworkers in the United States until December 3, 1986 which is the date the examiner believes is the earliest date of applicants reduction to practice in the United States. (For the reasons of record applicants believe that they have shown that their invention was reduced to practice in the United States prior to the date of the Asahi Shinbum article). The examiner has not rebutted applicants proof that applicants conception was in the United States at their direction prior to the date of the Asahi Shinbum article and the examiner has not denied that applicants have proven that they were diligent by instructing coworkers in the United States from a time prior to the date of the Asahi Shinbum article until the date the examiner believes is the date of applicants' date of reduction to practice in the United States. The details of applicants' proof are discussed at pages 22, line 8 to page 24, last line, of applicant's Substitute Amendment dated March 6, 1997.

The examiners response to applicants' proof is at page 19, paragraph d. ii of the final rejection "[t]he applicants further urge that they have shown clear diligence from before November 28, 1996 until actual reduction to practice at or around December 3, 1986. Nevertheless, the actual reduction in this country is deemed to have occurred on December 3, 1986, which is after the publication date for the reference."

Willson v. Sherts 81 F 2d 775, 28 USPQ 379 (CCPA 1936) held that an inventor who conceives an invention outside of the United States gets the benefit of the date that a third party, to whom the invention is disclosed, brings the conception into the United States (28 USPQ 379, 381) and that acts in this country done on behalf of the inventors can be used to show diligence to reduction to practice in the United States (28 USPQ 379, 383). Thus the rejections of applicants' claims under 35 USC 102 and 103 over the Asahi Shinbum article should be withdrawn.

Applicants are entitled to know why the examiner has maintained the rejection under 35 USC 102 and 103 over the Asahi Shinbum article in light of applicants proof which the examiner has not rebutted. Applicants are in the position of having to guess at what are the reasons for maintaining these rejections. Applicants cannot properly appeal these rejections with out knowing the examiner's reasons for maintaining the rejections.

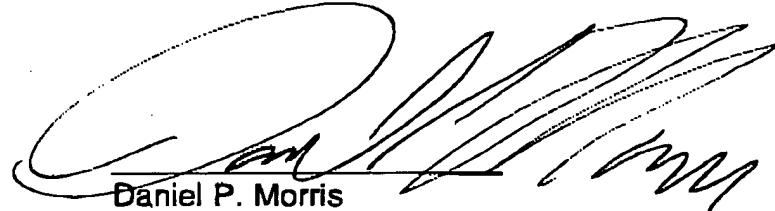
Applicants petition for withdrawal of the final rejection and request a new non-final action containing the reasons for why the examiner disagrees that applicants have proven that they their conception was in the United states at their direction prior to the Asahi Shinbum article and they were diligent in instructing coworkers in the United States to their reduction to practice in the United States and thereby have shown that the Asahi Shinbum article is not a reference applicable to their invention. Applicants believe they should be given an opportunity to know and rebut the undisclosed reasons of the examiner.

Respectfully submitted,

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